

## REMARKS

Claims 5-8 were pending and under consideration, claims 1-4 having been withdrawn from consideration pursuant to a restriction requirement.

In the non final Office Action mailed October 22, 2001, the Examiner requested that  
5 Applicants affirm the election to prosecute the Group II claims 5-8, asserted that a claim for priority under 35 USC 119(a)-(d) cannot be based on the Japanese Application filed on Friday, October 15, 1999, requested Applicants to designate Figures 14 and 15 by a legend, objected to the disclosure, objected to the claims 7 and 8, rejected claim 8 under 35 USC 112(2), rejected claims 5 and 8 under 35 USC 102(e), rejected claim 5 under 35 USC 102(b),  
10 rejected claim 8 under 35 USC 103(a), and indicated that dependent claim 7 (claim 5/6/7) is allowable

Claims 5-8 were canceled in favor of new claims 9-16. Claims 9-16 are new. Claims 9-16 now are pending and under consideration.

### **I. Election Restriction**

15 In an October 15, 2001 conversation with Examiner Markham, Attorney David Metzger provisionally elected to prosecute the Group II claims 5-8. The Examiner requested that Applicants affirm the election to prosecute the Group II claims 5-8.

Accordingly, Applicants hereby affirm the election to prosecute the Group II claims 5-8.

### **II. 35 USC 119(a)-(d) Priority**

20 The Examiner asserted that a claim for priority under 35 USC 119(a)-(d) cannot be based on the Japanese Application filed on Friday, October 15, 1999 because the instant application was filed on Monday, October 16, 2000.

As noted under 35 USC 21(b), "when the day, or the last day, for taking any action or  
25 paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or

a federal holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding secular or business day." Since the twelve month priority date from Friday, October 15, 1999 occurred on Sunday, October 15, 2000, 35 USC 21(b) permitted Applicants to take action of filing the instant application on Monday, October 16, 2000 and  
5 be within the twelve month priority requirement of 35 USC 119(a)-(d). Accordingly, Applicants respectfully request that the Examiner withdraw the assertion that a claim for priority under 35 USC 119(a)-(d) cannot be based on the Japanese Application filed on Friday, October 15, 1999 because the instant application was timely filed on Monday, October 16, 2000.

10 **III. MPEP 608.02(g) Drawings**

The Examiner requested Applicants to designate Figures 14 and 15 by a legend such as noted in the Office Action.

Since Applicants have amended the Figures as noted above, Applicants respectfully request that the Examiner withdraw the request to amend the Figures.

15 **IV. Specification**

The Examiner objected to the disclosure as including informalities. The Examiner stated that it is improper to incorporate essential material in the specification by reference to a foreign application as set out in Applicants' Amendment "A" and states that a particular phrase on page 22 is confusing.

20 Applicants' Amendment "A" incorporates material "to the extent permitted by law." In other words, to the extent that the law does not permit such incorporation, Applicants do not incorporate such material. Moreover, the Examiner has not identified what material is incorporated that is essential and that is not already provided in the remainder of the specification. Additionally, Applicants have amended the phrase on page 22. Accordingly,  
25 Applicants respectfully request that the Examiner withdraw the objection to the disclosure.

**V. Claim Objection: claims 7 and 8**

The Examiner objected to claims 7 and 8 as including noted informalities.

Since claims 7 and 8 are canceled, Applicants respectfully request that the Examiner withdraw the objection to the claims.

5 **VI. 35 USC 112(2): Claim 8**

The Examiner rejected claim 8 under 35 USC 112(2) as including noted indefinite language.

Since claim 8 is canceled, Applicants respectfully request that the Examiner withdraw the rejection to the claims.

10 **VII. 35 USC 102(e): Claims 5 and 8**

The Examiner rejected claims 5 and 8 under 35 USC 102(e) as anticipated by Sullivan (US 6,217,720).

Since claims 5 and 8 are canceled, Applicants respectfully request that the Examiner withdraw the rejection to the claims.

15 **VIII. 35 USC 102(b): Claim 5**

The Examiner rejected claim 5 under 35 USC 102(b) as anticipated by Barret '720 (US 6,217,720). The Examiner rejected claim 5 under 35 USC 102(b) as anticipated by Holland (US 4,311,725).

20 Since claim 5 is canceled, Applicants respectfully request that the Examiner withdraw the rejection to the claims.

**IX. 35 USC 103(a): Claim 6 and 8**

The Examiner rejected claim 8 under 35 USC 103(a) as unpatentable over Barret '002 (JP 11-119002 A). The Examiner rejected claims 6 and 8 under 35 USC 103(a) as unpatentable over Holland (US 4,311,725).

Since claims 6 and 8 are canceled, Applicants respectfully request that the Examiner withdraw the rejection to the claims.

**X. Allowable claims**

The Examiner indicated that dependent claim 7 (claim 5/6/7) is allowable.

5 **XI. New claims 9-16**

**A. New Claim 9**

As noted above, Applicants canceled claims 5-8. Moreover, the Examiner has indicated that dependent claim 7 (claim 5/6/7) is allowable. Here, Applicants have rewritten in independent form dependent claim 7 as new claim 9. Thus, new independent claim 9 is  
10 allowable.

Applicants' acts of canceling independent claim 5 and rewriting dependent claim 7 in independent form does not constitute a surrender of any elements present in the originally dependent claim 7, and thus does not prevent the application of the doctrine of equivalents to those elements. *Honeywell Intern. Inc. v. Hamilton Sundstrand Corp.*, 2001 WL 66348  
15 (D.Del. Jan. 8, 2001) (Only the Westlaw citation is currently available).

**B. New Claims 10-16**

The cited combination does not teach the subject matter of new claims 10-16. For example, independent claim 10 recites:

*controlling a thickness of no more than one layer by ... measuring an optical*  
20 *characteristic of the stack*

The methods taught in each the cited prior art documents take a lot of time to form the optical film composed of the optical thin layers since the film thickness adjustment is performed for each of the optical thin layers. This problem was noted in the specification at page 3, lines 15-19 with respect to the related art method set out in Barret '002 (JP 11-119002  
25 A).

As noted in the specification page 5, lines 14-17, the inventors overcome this problem "since the thickness of only a portion of the multi-layer film is measured, the film thickness control can be easily performed."

## **XII. Conclusion**

In view of the foregoing, it is believed that the claims now pending are in condition for allowance. Such action is earnestly solicited at the earliest possible date. If the Examiner believes that a conference would be of value in expediting the prosecution of this application, the Examiner is invited to telephone the undersigned counsel to arrange for such a conference.

Respectfully submitted,  
SONNENSCHN NATH & ROSENTHAL  
Attorneys for Applicants

Dated: December 11, 2001

By: David R. Metzger  
David R. Metzger, Esq.  
Reg. No. 32,919

<p>SONNENSCHN NATH &amp; ROSENTHAL P.O. Box 061080 Wacker Drive Station, Sears Tower Chicago, IL 60606-1080</p> <p>Attorney Customer Number: 026263 Phn: (312) 876-8000 Fax: (312) 876-7934</p>	<p><b><u>CERTIFICATE OF MAILING</u></b></p> <p>I hereby certify that this correspondence is being deposited with the United States Postal Service in an envelope addressed to: Box Non Fee Amendment, Assistant Commissioner for Patents, Washington, D.C. 20231 on December 11, 2001.</p> <p><u>Rose M. Garza</u> 12.11.01 Rose M. Garza Date: December 11, 2001</p>
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**XIII. APPENDIX TO RESPONSE "B" TO NON FINAL OFFICE ACTION:  
VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**SPECIFICATION**

**The paragraph beginning on page 22, line 5:**

Fig. 12 is a diagram showing one example of simulation of a change in mean  
5 transmittance in the case of gradually increasing the thickness of an optical thin layer by using  
the optical monitor, and Fig. 13 is a diagram showing one example of a difference in final  
transmittance distribution between an optical component in which the thickness adjustment  
by using the optical monitor is performed and an optical component in which the thickness  
adjustment by using the optical monitor is not performed.